

2007-1419

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**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**

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ARISTOCRAT TECHNOLOGIES AUSTRALIA PTY LIMITED  
and ARISTOCRAT TECHNOLOGIES, INC.,

Plaintiffs-Appellants,

v.

INTERNATIONAL GAME TECHNOLOGY  
and IGT,

Defendants-Appellees.

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Appeal from the United States District Court for the District of Nevada in  
Case No. 05-CV-820, Judge Brian E. Sandoval.

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**BRIEF OF DEFENDANTS-APPELLEES**  
**INTERNATIONAL GAME TECHNOLOGY AND IGT**

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September 28, 2007

## **CERTIFICATE OF INTEREST**

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certifies the following:

1. The full names of every party or amicus represented by us are:  
  
International Game Technology and IGT
  
2. The names of the real parties in interest represented by us are:  
  
N/A
  
3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by us are:  
  
International Game Technology has no parent corporation, and no publicly held company owns 10 percent or more of its stock. IGT is a wholly owned subsidiary of International Game Technology.
  
4. The names of all law firms and the partners or associates that appeared for the parties or amicus now represented by us in the trial court or that are expected to appear in this Court are:

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# TABLE OF CONTENTS

	<b>Page</b>
TABLE OF AUTHORITIES .....	iii
STATEMENT OF THE ISSUES.....	1
STATEMENT OF FACTS .....	2
A.    The '102 Patent .....	2
B.    Claim 1 And The “Game Control Means” .....	3
C.    District Court Proceedings .....	5
SUMMARY OF THE ARGUMENT .....	7
ARGUMENT .....	10
I.    A MEANS-PLUS-FUNCTION CLAIM IS FATALLY INDEFINITE IF ITS SPECIFICATION FAILS TO DISCLOSE ADEQUATE STRUCTURE .....	11
II.   THE SPECIFICATION OF THE '102 PATENT DOES NOT DISCLOSE THE REQUIRED STRUCTURE.....	14
A.    The Specification’s Reference To “Standard Microprocessor Base[d] Gaming Machine By Means Of Appropriate Programming” Does Not Disclose The Required Structure .....	15
1.    The structure disclosed in the specification of a computer-based means-plus-function claim cannot be limited to a general purpose computer.....	16
2.    Because the specification of the patent at issue does not disclose an algorithm or equivalent structure, it does not meet the structure disclosure requirement .....	22
a.    Aristocrat seeks to reduce the structure disclosure requirement to meaninglessness .....	23

**TABLE OF CONTENTS**  
**(Continued)**

	<b>Page</b>
b. Aristocrat cannot conjure up the required algorithm or equivalent structure.....	26
B. Aristocrat’s Expert Cannot Overcome The Specification’s Failure To Disclose Corresponding Structure.....	32
III. ALTERNATIVELY, THE ’102 PATENT IS FATALLY INDEFINITE BECAUSE ITS SPECIFICATION FAILS TO LINK ANY STRUCTURE TO THE RECITED FUNCTIONS.....	35
IV. ARISTOCRAT’S ADDITIONAL ARGUMENTS ARE BASELESS.....	39
CONCLUSION .....	41

## TABLE OF AUTHORITIES

	Page(s)
<b>Cases</b>	
<i>Adrain v. Superchips, Inc.</i> , 218 F. App'x 982 (Fed. Cir. 2007) .....	37
<i>Alappat, In re</i> , 33 F.3d 1526 (Fed. Cir. 1994) .....	16, 24
<i>Altiris, Inc. v. Symantec Corp.</i> , 318 F.3d 1363 (Fed. Cir. 2003) .....	27
<i>Atmel Corp. v. Information Storage Devices, Inc.</i> , 198 F.3d 1374 (Fed. Cir. 1999) .....	28, 30, 34
<i>B. Braun Med., Inc. v. Abbott Labs.</i> , 124 F.3d 1419 (Fed. Cir. 1997) .....	36, 39
<i>Billingnetwork.com, Inc. v. Cerner Physician Practice, Inc.</i> , 2007 WL 879409 (M.D. Fla. Mar. 21, 2007) .....	22
<i>Biomedino, LLC v. Waters Techs. Corp.</i> , 490 F.3d 946 (Fed. Cir. 2007) .....	<i>passim</i>
<i>Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.</i> , 296 F.3d 1106 (Fed. Cir. 2002) .....	11, 13, 34
<i>Creo Prods., Inc. v. Presstek, Inc.</i> , 305 F.3d 1337 (Fed. Cir. 2002) .....	16
<i>Datamize, LLC v. Plumtree Software, Inc.</i> , 2004 U.S. Dist. LEXIS 28382 (N.D. Cal. July 9, 2004), <i>aff'd</i> , 417 F.3d 1342 (Fed. Cir. 2005) .....	40
<i>Datamize, LLC v. Plumtree Software, Inc.</i> , 417 F.3d 1342 (Fed. Cir. 2005) .....	11, 31
<i>DE Technology, Inc. v. Dell, Inc.</i> , 428 F. Supp. 2d 512 (W.D. Va. 2006) .....	18, 19, 40
<i>Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A., Inc.</i> , 389 F. Supp. 2d 1325 (S.D. Fla. 2004), <i>aff'd</i> , 412 F.3d 1291 (2005) .....	40
<i>Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A., Inc.</i> , 412 F.3d 1291 (Fed. Cir. 2005) .....	<i>passim</i>

<i>Donaldson Co., In re</i> , 16 F.3d 1189 (Fed. Cir. 1994) .....	11
<i>Dossel, In re</i> , 115 F.3d 942 (Fed. Cir. 1997).....	24, 25, 41
<i>Finisar Corp. v. DirecTV Group</i> , 416 F. Supp. 2d 512 (E.D. Tex. 2006).....	19, 20
<i>Gobeli Research, Ltd. v. Apple Computer Inc.</i> , 384 F. Supp. 2d 1016 (E.D. Tex. 2005).....	19, 20
<i>Harrah’s Entertainment, Inc. v. Station Casinos, Inc.</i> , 321 F. Supp. 2d 1173 (D. Nev. 2004), aff’d, 154 F. App’x 928 (Fed. Cir. 2005).....	22
<i>Harris Corp. v. Ericsson Inc.</i> , 417 F.3d 1241 (Fed. Cir. 2005) ....	17, 21, 23, 24, 25
<i>Honeywell Int’l, Inc. v. International Trade Comm’n</i> , 341 F.3d 1332.....	11, 40
<i>Iwahashi, In re</i> , 888 F.2d 1370 (Fed. Cir. 1989) .....	20
<i>JVW Enters., Inc. v. Interact Accessories, Inc.</i> , 424 F.3d 1324 (Fed. Cir. 2005) .....	36
<i>Key Pharms. v. Hercon Labs. Corp.</i> , 161 F.3d 709 (Fed. Cir. 1998).....	26
<i>Mars Inc. v. Kabushiki-Kaisha Nippon Conlux</i> , 24 F.3d 1368 (Fed. Cir. 1994) .....	37
<i>Maurice Mitchell Innovations, L.P. v. Intel Corp.</i> , No. 2007-1108, Slip Op. (Fed. Cir. Sept. 24, 2007).....	14
<i>McKesson Info. Solutions LLC v. Trizetto Group</i> , 426 F. Supp. 2d 197 (D. Del. 2006).....	18, 22
<i>Medical Instrumentation &amp; Diagnostics Corp. v. Elekta AB</i> , 344 F.3d 1205 (Fed. Cir. 2003) .....	<i>passim</i>
<i>Medtronic, Inc. v. Advanced Cardiovascular Sys., Inc.</i> , 248 F.3d 1303 (Fed. Cir. 2001) .....	36
<i>Metrologic Instruments, Inc. v. Symbol Technologies, Inc.</i> , 460 F. Supp. 2d 571 (D.N.J. 2006).....	19
<i>Michlin, In re</i> , 256 F.2d 317 (C.C.P.A. 1958).....	29

<i>Oakley, Inc. v. Sunglass Hut Int’l</i> , 316 F.3d 1331 (Fed. Cir. 2003).....	40
<i>Omega Eng’g, Inc. v. Raytek Corp.</i> , 334 F.3d 1314 (Fed. Cir. 2003).....	36, 38
<i>Overhead Door Corp. v. Chamberlain Group</i> , 194 F.3d 1261 (Fed. Cir. 1999) .....	21
<i>Rembrandt Tech., L.P. v. Comcast Corp.</i> , 2007 WL 1643177 (E.D. Tex. June 5, 2007).....	18
<i>Sage Prods., Inc. v. Devon Indus., Inc.</i> , 126 F.3d 1420 (Fed. Cir. 1997) .....	27
<i>State Street Bank &amp; Trust Co. v. Signature Fin. Group</i> , 149 F.3d 1368 (Fed. Cir. 1998) .....	20
<i>Tehrani v. Hamilton Med., Inc.</i> , 331 F.3d 1355 (Fed. Cir. 2003) .....	17, 22
<i>Touchcom, Inc. v. Dresser, Inc.</i> , 427 F. Supp. 2d 730 (E.D. Tex. 2005) .....	20
<i>WMS Gaming Inc. v. International Game Tech.</i> , 184 F.3d 1339 (Fed. Cir. 1999) .....	16, 22, 23, 24, 25, 41

**Statutes, Regulation, and Rule**

35 U.S.C. § 112, ¶ 2 .....	11, 12, 21
35 U.S.C. § 112, ¶ 6.....	<i>passim</i>
35 U.S.C. § 282.....	41
37 C.F.R. § 1.75(d)(1).....	4
FED. R. CIV. P. 56(c).....	10

## **STATEMENT OF RELATED CASES**

No other appeal in or from this civil action was previously before this or any other appellate court. No case is known to counsel for defendants/appellees to be pending in this or any other court that will directly affect or be directly affected by this Court's decision in the pending appeal.

## **STATEMENT OF THE ISSUES**

1. Whether the district court properly held that the patent at issue is invalid for indefiniteness where the sole purported structure corresponding to the "game control means" limitation is a "standard microprocessor base[d] gaming machine by means of appropriate programming, plus equivalents."

2. Whether the district court properly held, in the alternative, that the patent at issue is invalid for indefiniteness where the specification fails to link any structure to the claimed functions of the "game control means" limitation.

## STATEMENT OF FACTS

The Statement of Facts of Plaintiffs-Appellants Aristocrat Technologies Australia Pty Limited and Aristocrat Technologies, Inc. (collectively, “Aristocrat”) improperly assumes as facts what are actually Aristocrat’s views on the legal questions at issue on this appeal. For example, Aristocrat (Br. 13-14) asserts, contrary to the district court’s ruling, that the patent claim at issue describes an “algorithm” and that the patent’s written description discloses “structure.” For that reason, Defendants-Appellees International Game Technology and IGT (collectively, “IGT”) submit the following statement of facts.

### **A. The ’102 Patent**

The patent-in-suit in this case is U.S. Patent No. 6,093,102 (the “’102 patent”), entitled “Multiline Gaming Machine.” JA0301. The ’102 patent relates to improved “multiline” gaming machines, generally known as slot machines. It was issued by the United States Patent and Trademark Office on July 25, 2000 and claims priority to an Australian application filed on September 15, 1994. *Id.*

The ’102 patent describes a type of slot machine that purports to increase player interest over prior art slot machines by enabling the player to control the definition of pay lines. The number of pay lines provided on the slot machine, particularly a machine with a 3x5 display, can be increased without changing the display format. JA0306 (Col. 2, lns. 3-6). The multiline gaming format of the

'102 patent allows the player to increase the number of winning combinations for each game by making multiple bets simultaneously. JA0307 (Col. 3, lns. 35-37).

Prior art gaming machines enabled the player to select multiple predefined pay lines. JA0307 (Col. 3, lns. 26-28). By contrast, the invention described in the '102 patent enables a player to define one or more pay lines by selecting symbol positions and to obtain a payout if selected symbols appear in consecutive columns. JA0308 (Col. 6, lns. 1-17). The pay lines need not be straight lines, and winning matches need not be in the same row. JA0306 (Col. 1, lns. 62-66). Payouts are determined based on the number of pay lines that traverse or pass through the winning symbol combination. In the first embodiment of the claimed invention, one with a 3x5 display, there are 243 possible pay lines. JA0307 (Col. 3, lns. 48-53).

#### **B. Claim 1 And The “Game Control Means”**

Claim 1 is the only independent claim of the '102 patent and reads as follows:

1. A gaming machine having display means arranged to display a plurality of symbols in a display format having an array of  $n$  rows and  $m$  columns of symbol positions, game control means arranged to control images displayed on the display means, the game control means being arranged to pay a prize when a predetermined combination of symbols is displayed in a predetermined arrangement of symbol positions selected by a player, playing a game, including one and only one symbol position in each column of the array, the gaming machine

being characterised in that selection means are provided to enable the player to control a definition of one or more predetermined arrangements by selecting one or more of the symbol positions and the control means defining a set of predetermined arrangements for a current game comprising each possible combination of the symbol positions selected by the player which have one and only one symbol position in each column of the display means, wherein the number of said predetermined arrangements for any one game is a value which is the product  $k_1 \dots x \dots k_i \dots x \dots k_m$  where  $k_i$  is a number of symbol positions which have been selected by the player in an  $i^{\text{th}}$  column of the  $n$  rows by  $m$  columns of symbol positions on the display ( $0 < i \leq m$  and  $k_i \leq n$ ).

JA0308 (Col. 5, ln. 63 to Col. 6, ln. 17).

Claim 1 thus expressly includes a “game control means” limitation.<sup>1</sup>

It delineates the following three functions performed by “game control means”: (1) control images on the slot machine’s display means; (2) pay a prize when a predetermined combination of symbols matches the symbol positions selected by the player; and (3) define the pay lines for a game according to each possible combination of those selected symbol positions.

JA0308 (Col. 5, ln. 65 to Col. 6, ln. 11).

In addition, according to the ’102 patent specification, “it is to be understood that it is within the capabilities of the non-inventive worker in

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<sup>1</sup> “Game control means” is recited twice, and “control means” is recited once, in claim 1. “Control means” is presumably the same limitation as “game control means,” but has no antecedent basis. See 37 C.F.R. § 1.75(d)(1). Aristocrat has consistently treated the terms “game control means” and “control means” as identical. See, *e.g.*, JA0288-0289.

the art to introduce the methodology on any standard microprocessor base gaming machine by means of appropriate programming.” JA0306 (Col. 2, ln. 66) – JA0307 (Col. 3, ln. 4).

### **C. District Court Proceedings**

Aristocrat filed suit against IGT in June 2005, claiming that IGT’s MultiWay<sup>®</sup> gaming machines infringed one or more claims of the ’102 patent. After the parties each filed *Markman* claim construction briefs, IGT filed a motion for summary judgment of patent invalidity, contending that the specification of the ’102 patent fails to describe the structure corresponding to the patent’s means-plus-function claims as required by 35 U.S.C. § 112, ¶ 6. JA0526.

The district court granted IGT’s motion for summary judgment of patent invalidity. JA0001-0012. The court found the term “game control means” to be indefinite under § 112, ¶ 6 because Aristocrat “failed to link” any structure to the means-plus-function limitation. JA0010. The court therefore concluded that claim 1, the only independent claim of the ’102 patent, is “invalid as indefinite” because it “fails to fulfill the requirements of section 112, paragraph 2.” JA0011-0012.

The district court rejected Aristocrat’s contention that specifying the supposedly corresponding structure as “the standard microprocessor base gaming machine by means of appropriate programming plus equivalents” is sufficient to satisfy § 112, ¶ 6. JA0008. The court found that this specification “does not

identify any structure as the game control means” or “provide any guidance to determine the meaning of ‘standard microprocessor’ or ‘appropriate programming,’” because it offered “nothing more [to] clarify or define these terms.” *Id.* The court relied on this Court’s precedents requiring a “specific algorithm for reciting the function” to transform a “general purpose computer, or microprocessor” into a “special purpose computer” that is “programmed to perform particular functions pursuant to instructions from program software.” *Id.* at JA0008-0009.

The court found that the ’102 patent fails to comply with those requirements because it “does not have any specific algorithm that describes or recites the claimed function.” *Id.* at JA0010. It “contains no step-by-step process for performing the claimed functions of controlling images on the slot machines video screen, paying a prize when a predetermined combination of symbols comes up or defining the pay lines for games.” *Id.* Accordingly, the court concluded, the specification does not sufficiently describe “what Aristocrat is claiming as its own.” *Id.*

The court added that, even if the ’102 patent had described the structure sufficiently, it would be fatally indefinite for failing “to link the structure to the means-plus-function.” JA0010. The court explained that there is nothing within the specification which clearly links any structure to the functions. *Id.*

The district court also rejected Aristocrat’s contention that its submission of an expert declaration precluded summary judgment on this issue. The court explained that testimony from one skilled in the art “does not relieve the patentee of the duty of fully describing the corresponding structure in the patent specification.” JA0009. The court added that a patentee may not rely on an expert declaration to “clearly link the claimed function and structure” where the specification itself fails to do so. JA0011.

Because the district court found the sole independent claim of the ’102 patent to be invalid, it held that all dependent claims were likewise invalid. JA0012. The court subsequently denied Aristocrat’s motion to alter or amend the judgment, and this appeal followed.<sup>2</sup>

### **SUMMARY OF THE ARGUMENT**

The district court correctly ruled that the “game control means” limitation in the sole independent claim of the ’102 patent is fatally indefinite. The specification of a means-plus-function claim, such as claim 1 of the ’102 patent, must disclose the structure that performs the recited functions. The specification of

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<sup>2</sup> In rejecting Aristocrat’s motion to alter or amend the judgment, the district court made clear that it had granted International Game Technology’s motion for summary judgment on its counterclaim of non-infringement, which was based on the fact that International Game Technology is merely a holding company that owns all the outstanding stock of IGT but does not make, use, offer to sell, or sell any products. JA0016.

the '102 patent does not disclose the required structure, rendering the game control means term fatally indefinite and invalidating claim 1 and all dependent claims.

The specification's reference to a "standard microprocessor base[d] gaming machine with appropriate programming" does not disclose the required structure. The specification provides no guidance as to the meaning of "standard microprocessor" or "appropriate programming." Disclosing a generic computer with unspecified software does not provide the notice to the public that 35 U.S.C. § 112, ¶ 6 requires in return for the right to assert a means-plus-function claim.

This Court's precedents suggest that the structure required for a computer-implemented means-plus-function claim is a specific algorithm that sets forth the steps by which the computer performs the recited functions. Such an algorithm transforms a general purpose computer into a special purpose computer programmed to perform the algorithm and enable the patented device to perform those functions. The '102 patent specification does not disclose any such algorithm and therefore discloses only a general purpose computer. Accordingly, the district court properly ruled that the specification fails to disclose the necessary structure.

Even if a specific algorithm were not required, the specification had to disclose more than a generic microprocessor with an unspecified program. It does not name any software program, any category of software program, any software

program provider, any book or manual describing a software program, or even a chart illustrating structure corresponding to the asserted means. Thus, it fails to comport with the established patent law requirement that the specification of a means-plus-function claim disclose the corresponding structure.

Aristocrat denies that disclosure of anything more than a standard microprocessor with appropriate programming is required to avoid invalidity for indefiniteness. But its arguments are at odds both with this Court's precedents and with the uniform rulings of the district courts facing this issue. Recognizing that difficulty, Aristocrat additionally argues that the '102 specification does disclose an algorithm. But it waived its arguments on that score by not raising them in the district court, and in any event its hunt for such an algorithm comes up empty. Aristocrat also tries to supply the missing structure through an expert declaration. But this Court has made clear that the required structure must be disclosed in the specification itself, and Aristocrat's expert did not identify any such structure in the specification.

Even if the '102 patent specification did disclose structure, it does not link that structure to the claimed functions, an alternative ground for affirming the district court's judgment. Aristocrat tries to substitute a "methodology" of play for the required link, but that stratagem does not comport with the statutory mandate

or this Court's precedents. Moreover, a method of play does not link structure to function for purposes of an apparatus or device claim such as the one at issue here.

Aristocrat offers two additional arguments, each without merit. First, it contends without support that the district court should not have ruled on indefiniteness before entering a *Markman* order. But it is well established that a claim is indefinite and cannot be construed when no structure is disclosed for a means-plus-function term. Moreover, Aristocrat offers no reason to think that choosing between the parties' constructions of "game control means," as it contends the district court should have done, would have made any material difference to the outcome of the indefiniteness issue. Second, Aristocrat contends (again without support) that the PTO examiner's issuance of the '102 patent somehow strengthens the established presumption of validity. It is just as well established that clear and convincing evidence of indefiniteness rebuts that presumption. Here, the evidence that the specification fails to disclose the required structure was not only clear and convincing but compelling. Hence, the district court properly held the patent invalid, a ruling this Court should affirm.

### **ARGUMENT**

Summary judgment should be granted when there are no genuine issues of material fact and the moving party is entitled to judgment as a matter of law. FED. R. CIV. P. 56(c); *Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A., Inc.*,

412 F.3d 1291, 1297-98 (Fed. Cir. 2005). Summary judgment is particularly appropriate on a defense of invalidity for indefiniteness because “[a] determination of claim indefiniteness is a legal conclusion that is drawn from the court’s performance of its duty as the construer of patent claims.” *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005) (affirming summary judgment of invalidity for indefiniteness).

**I. A MEANS-PLUS-FUNCTION CLAIM IS FATALY INDEFINITE IF ITS SPECIFICATION FAILS TO DISCLOSE ADEQUATE STRUCTURE.**

35 U.S.C. § 112, ¶ 2 requires that a patent specification conclude with claims that particularly point out and distinctly claim the subject matter of the claimed invention. Failure to do so renders a claim indefinite, and a claim that is indefinite is invalid. *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1114-16 (Fed. Cir. 2002); *In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994) (en banc). The purpose of the definiteness requirement is “to ensure that the claims delineate the scope of the invention using language that adequately notifies the public of the patentee’s right to exclude.” *Datamize*, 417 F.3d at 1347 (citing *Honeywell Int’l, Inc. v. International Trade Comm’n*, 341 F.3d 1332, 1338 (Fed. Cir. 2003)).

The principles governing whether a means-plus-function claim is sufficiently definite to resist an invalidity defense are well settled. This Court

recently summarized those principles in *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946 (Fed. Cir. 2007), a case not mentioned in Aristocrat’s brief.

As explained in *Biomedino*, 490 F.3d at 950, when a claim limitation uses the word “means,” 35 U.S.C. § 112, ¶ 6 presumptively applies. Paragraph 6 permits a claim limitation to be expressed as a means to perform a specified function without claiming the structure that performs the function. *Id.* at 948.

Paragraph 6 provides:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Means-plus-function claims still must satisfy the definiteness requirements set forth in § 112, ¶ 2, and thus the *quid pro quo* for the “generic claiming ability” provided by ¶ 6 is that the applicant “must indicate in the specification what structure constitutes the means.” *Biomedino*, 490 F.3d at 948 & n.1; see *Default Proof*, 412 F.3d at 1298 (corresponding structure “must include all structure that actually performs the recited function”).

Accordingly, once the court determines the function, it must look to the specification and identify the corresponding structure, if any, for that function. *Biomedino*, 490 F.3d at 950. The specification must disclose the corresponding structure “in such a manner that one skilled in the art will know and understand

what structure corresponds to the means limitation.” *Id.* The test is whether one skilled in the art “would understand the specification itself to disclose a structure, not simply whether that person would be capable of implementing a structure.” *Id.* at 953 (citing *Medical Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1212 (Fed. Cir. 2003)). Thus, the testimony of one skilled in the art “cannot supplant the total absence of structure from the specification.” *Biomedino*, 490 F.3d at 950. And a “bare statement that known techniques or methods can be used does not disclose structure.” *Id.* at 953.

This Court frequently has held means-plus-function patent claims invalid for indefiniteness where the specification fails to disclose the required structure. For example, in *Biomedino*, 490 F.3d at 949, 952, the Court held a patent invalid for indefiniteness after concluding “there is nothing to suggest a structure for the claimed control means” based on a specification that said “nothing more than that unspecified equipment may be used to control the regeneration process.” In *Default Proof*, 412 F.3d at 1292-93, the Court reached the same result where the patent at issue disclosed no structure corresponding to the “means for dispensing at least one debit card” limitation in the claim. And in *Cardiac Pacemakers*, 296 F.3d at 1118-19, the Court held a means-plus-function claim invalid for indefiniteness where the specification failed to disclose structure corresponding to

“third monitoring means.” See also *Maurice Mitchell Innovations, L.P. v. Intel Corp.*, No. 2007-1108, Slip Op. (Fed. Cir. Sept. 24, 2007).

These examples (we could cite many others) and the principles they embody reflect “worthy goals.” *Medical Instrumentation*, 344 F.3d at 1220. The public should not have “to guess as to the structure for which the patentee enjoys the right to exclude,” but rather “is entitled to know precisely what kind of structure the patentee has selected for the claimed functions.” *Id.* Thus, “[p]recision in claiming is not an unreasonable price to pay to gain the benefits of claiming in functional terms under section 112, paragraph 6.” *Id.*

## **II. THE SPECIFICATION OF THE '102 PATENT DOES NOT DISCLOSE THE REQUIRED STRUCTURE.**

The “game control means” limitation in claim 1 of the '102 patent is in a means-plus-function format, and the parties do not dispute that § 112, ¶ 6 governs. See *Aristocrat Br. 22*. As the district court properly determined, the specification does not disclose any structure corresponding to the “game control means” limitation in claim 1, as required by ¶ 6. *Aristocrat* is attempting to broadly claim a functional limitation unbounded by corresponding structure in the specification, precisely what this Court’s cases forbid.

**A. The Specification’s Reference To “Standard Microprocessor Base[d] Gaming Machine By Means Of Appropriate Programming” Does Not Disclose The Required Structure.**

According to Aristocrat, the “corresponding structure for all three functions of ‘game control means’” is a “‘standard microprocessor base[d] gaming machine’ with ‘appropriate programming.’” Aristocrat Br. 30 (quoting JA0023 (Col. 3:1-4)). As the table below illustrates, that disclosure cannot begin to carry the weight asserted by Aristocrat.

<b>“Game Control Means” Functions as Claimed</b>	<b>Aristocrat’s Alleged Corresponding Structure</b>
<p><b>Function:</b> control images displayed on the display means.</p> <p><b>Function:</b> pay a prize when a predetermined combination of symbols is displayed in a predetermined arrangement of symbol positions selected by a player, playing a game, including one and only one symbol position in each column of the array.</p> <p><b>Function:</b> defining a set of predetermined arrangements for a current game comprising each possible combination of the symbol positions selected by the player which have one and only one symbol position in each column of the display means.</p>	<p>standard microprocessor base[d] gaming machine by means of appropriate programming.</p>

JA0307 (Col. 3, Ins. 2-4); JA0308 (Col. 5, ln. 65 to Col. 6, ln. 13). That reference does not disclose structure corresponding to any of the functions performed by the

“game control means.” It provides no guidance as to the meaning of “standard microprocessor” or “appropriate programming.” Thus, the means claimed by Aristocrat for its supposedly patentable gaming machine amounts to a general computer with unspecified programming. That description is far too generic to satisfy the requirements of § 112.

**1. The structure disclosed in the specification of a computer-based means-plus-function claim cannot be limited to a general purpose computer.**

This Court has made clear that, where the disclosed structure is a computer or microprocessor, the specification must describe structure that transforms the general purpose computer or microprocessor into a “special purpose computer” that is “programmed to perform particular functions pursuant to instructions from program software.” *WMS Gaming Inc. v. International Game Tech.*, 184 F.3d 1339, 1348-49 (Fed. Cir. 1999) (quoting *In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994) (en banc)). For a means-plus-function claim, “the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.” *Id.* at 1349. It is the algorithm-driven program that transforms a generic computer-based machine into “a new machine” subject to patentability. *Id.* at 1348; see also *Creo Prods., Inc. v. Presstek, Inc.*, 305 F.3d 1337, 1345 (Fed. Cir. 2002) (labeling “correct” a party’s reliance on *WMS Gaming* “for the proposition that a computer-implemented

means-plus-function claim is limited to a computer programmed to perform the algorithm disclosed in the specification”).

Six years after *WMS Gaming*, this Court confirmed that, for a computer-implemented means-plus-function term, “the corresponding structure is the algorithm.” *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1253 (Fed. Cir. 2005). In *Harris*, the Court rejected the proposition that the corresponding structure of the claimed “time domain processing means” could be “merely a ‘symbol processor,’ as the district court held.” *Id.* at 1254. Rather, under what the Court called “the algorithm rule” (*id.* at 1249), in a means-plus-function claim in which the disclosed structure is a computer or microprocessor, the required corresponding structure must be a “specific algorithm disclosed in the specification.” *Id.* at 1253.

At a minimum, then, *WMS Gaming* and *Harris* suggest that where the specification’s sole reference to structure is a computer with programming, the specification must disclose a specific algorithm to avoid indefiniteness. See also *Tehrani v. Hamilton Med., Inc.*, 331 F.3d 1355, 1362 (Fed. Cir. 2003) (reversing summary judgment of infringement and remanding “to determine what algorithm forms part of the structure of the ‘means for processing’ limitation”). The district court therefore properly ruled that the failure of the ’102 patent to disclose any algorithm or anything comparable made it indefinite. The district court did not, as *Aristocrat* suggests (Br. 30), require “an unending disclosure of what everyone in

the field knows.” It simply required that the ’102 patent describe the steps by which its claimed functions are accomplished. That ruling is consistent with those of all other district courts confronting this issue after *WMS Gaming* and *Harris*.

- In *Rembrandt Tech., L.P. v. Comcast Corp.*, 2007 WL 1643177, at \*10 (E.D. Tex. June 5, 2007), the court could not identify any corresponding structure from a mere reference to “programmable hardware (*i.e.*, a control processor or digital signal processor chip) configured to perform the function set forth in Fig. 8,” where Figure 8 was “purely a functional diagram and no algorithm has been disclosed.”
- In *McKesson Info. Solutions LLC v. Trizetto Group*, 426 F. Supp. 2d 197, 202 (D. Del. 2006), the court required “specific algorithms” for computer-based means-plus-function limitations, explaining that “merely stating ‘software’ is insufficient.”
- In *DE Technology, Inc. v. Dell, Inc.*, 428 F. Supp. 2d 512, 516 (W.D. Va. 2006), the court held that a claim describing the means for running a transaction program so as to integrate components was invalid for indefiniteness based on “the algorithm rule of *WMS Gaming* and *Harris*” applicable to “means-plus-functions in which the disclosed structure is a computer.” The court explained that a

corresponding structure “must be a specific algorithm disclosed in the specification,” not merely “an algorithm executed by a computer” or “described by sources outside of the specification.” *Id.* Thus, a “[d]isclosure of ‘computers’ or ‘software’ [is] not sufficient to satisfy the algorithm rule.” *Id.* at 520.

- In *Metrologic Instruments, Inc. v. Symbol Technologies, Inc.*, 460 F. Supp. 2d 571, 624 (D.N.J. 2006), the court held that “when corresponding structure includes a ‘programmable microprocessor,’ it must also include an algorithm.”
- In *Finisar Corp. v. DirecTV Group*, 416 F. Supp. 2d 512, 518-19 (E.D. Tex. 2006), the function was “generating a hierarchically arranged set of indices, and embedding those indices in the information database.” The court found the claimed means indefinite because the specification described “no algorithm, formula, or series of steps performed by the computer to accomplish the function of generating indices and embedding them.”
- In *Gobeli Research, Ltd. v. Apple Computer Inc.*, 384 F. Supp. 2d 1016, 1022-23 (E.D. Tex. 2005), the court rejected the plaintiff’s contention that “a microprocessor running a procedure call that

sets aside resources, such as a memory area,” was sufficient to satisfy the corresponding structure requirement, explaining that it “does not set forth any algorithm for reciting the function.”

- In *Touchcom, Inc. v. Dresser, Inc.*, 427 F. Supp. 2d 730, 736 (E.D. Tex. 2005), the court found “no structure in the ’282 patent, in the form of an algorithm, which corresponds to the function of controlling the display and input means.”

Aristocrat (Br. 47 n.13) dismisses the significance of these district court cases. But the fact that the district courts have uniformly required an algorithm to transform a general purpose computer into a special purpose computer underscores the validity of that approach and its practical utility in ensuring that computer-based means-plus-function claims are sufficiently definite.

It should be noted that an algorithm need not be unduly technical or onerous. An algorithm is simply a “step-by-step process.” *State Street Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368, 1374 (Fed. Cir. 1998); see also *In re Iwahashi*, 888 F.2d 1370, 1374 (Fed. Cir. 1989) (“The preferred definition of ‘algorithm’ in the computer art is [a] fixed step-by-step procedure for accomplishing a given result”). Disclosing an algorithm does not require disclosing the computer’s source code because an algorithm can be “expressed textually, or shown in a flow chart.” *Finisar*, 416 F. Supp. 2d at 518; see *Gobeli*

*Research*, 384 F. Supp. 2d at 1023 (the plaintiff could have avoided indefiniteness by providing “figures or flow charts that describe the algorithm”). But if the means to a function is a programmed computer, the specification should at least disclose the sequence of steps that the computer is to perform to carry out each of the recited functions. *Harris*, 417 F.3d at 1253. The district court did not hold, and IGT does not contend, that a patent must disclose the precise programming language that yields the commercial embodiments of the invention, as Aristocrat posits (Br. 35). But it is only reasonable that an inventor seeking to take advantage of § 112, ¶ 6 describe the steps by which the claimed functions are accomplished with the particularity and distinctness required by § 112, ¶ 2. And even if disclosure of a specific algorithm is not an absolute requirement, disclosure of nothing more than a generically programmed computer cannot be sufficient to describe how the claimed invention performs those functions.

Disclosure of sufficient structure is important both to the public and to the courts. The public must know the steps by which the claimed invention accomplishes its functions so that it will have notice of the permissible boundaries to inventing around it. See *Default Proof*, 412 F.3d at 1302-03. Disclosure of an algorithm or equivalent structure also permits the courts, in the event of an infringement claim, to compare the workings of the accused device with the claimed invention. See *Overhead Door Corp. v. Chamberlain Group*, 194 F.3d

1261, 1273 (Fed. Cir. 1999) (reversing summary judgment of infringement where the software disclosed in the means-plus-function patent claim at issue “uses a different algorithm to perform the recited function”); *Tehrani*, 331 F.3d at 1367 (district court must “explicitly compare [the patent’s] algorithm with that used by the accused device” to determine infringement); *McKesson*, 426 F. Supp. 2d at 202 (granting summary judgment of noninfringement where plaintiff’s failure to identify specific algorithms constituting structure did not allow comparison of disclosed structure to accused structure); *Billingnetwork.com, Inc. v. Cerner Physician Practice, Inc.*, 2007 WL 879409, at \*10-11 (M.D. Fla. Mar. 21, 2007) (same). As explained below, mere disclosure of a standard microprocessor and unspecified programming does not serve these important patent law purposes.

**2. Because the specification of the patent at issue does not disclose an algorithm or equivalent structure, it does not meet the structure disclosure requirement.**

The specification of claim 1 of the ’102 patent discloses no algorithm or any step-by-step process or equivalent structure by which the required computer is to perform the recited game control functions. It discloses only a “general purpose computer or microprocessor,” not the required algorithm-driven “special purpose computer.” See *WMS Gaming*, 184 F.3d at 1348-49. Hence, Aristocrat effectively claims functions without limiting the means by which one might accomplish those functions. See *Harrah’s Entertainment, Inc. v. Station Casinos, Inc.*, 321 F. Supp.

2d 1173, 1179 (D. Nev. 2004), aff'd, 154 F. App'x 928 (Fed. Cir. 2005). The recited functions — controlling images, paying a prize, and defining pay lines on a gaming machine — do not just happen. They are the result of a series of steps that a mere reference to a computer and unspecified software does nothing to disclose.

Aristocrat responds that a computer-based means-plus-function claim need not disclose any structure beyond a standard microprocessor and unspecified programming, and, even if it must, that the '102 patent does disclose a specific algorithm. Aristocrat is wrong on both counts.

*a. Aristocrat seeks to reduce the structure disclosure requirement to meaninglessness.*

According to Aristocrat (Br. 47), computer-implemented means-plus-function claims need not disclose a corresponding algorithm or equivalent structure. See also *id.* at 30 (“the disclosure of an implementing algorithm is not strictly necessary”). To sustain that conclusion, Aristocrat must overcome the teachings of *WMS Gaming* and *Harris*. Aristocrat (Br. 52) attempts to do so by reducing those leading cases to the “unremarkable proposition that mean-plus-function claim limitations should be limited to the structure disclosed in the written description.” But that cramped reading of *WMS Gaming* and *Harris* omits their extended explanations of the need for an algorithm to transform a general purpose computer to a special computer than can perform the recited instructions through programmed instructions.

To be sure, the specifications in *WMS* and *Harris* did disclose algorithms which limited the scope of the claims at issue. But that distinction from the '102 patent actually refutes Aristocrat's position. If a disclosed algorithm is required to provide the special purpose computer that can perform the recited functions, it follows *a fortiori* that if no algorithm is disclosed, the computer remains one of "general purpose" and thus a reference to it is too indefinite to disclose the required structure.

Aristocrat recognizes that it stands alone in its reading of *WMS Gaming* and *Harris*. It therefore contends (Aristocrat Br. 52-55) that requiring disclosure of an algorithm or equivalent structure would conflict with prior precedent, namely, *In re Dossel*, 115 F.3d 942 (Fed. Cir. 1997). But nothing in *WMS Gaming* or *Harris* departed from prior precedent. The Court in *WMS Gaming*, 184 F.3d at 1349, relied on this Court's *en banc* decision in *Alappat*, 33 F.3d at 1545, which preceded *Dossel* by three years.

Moreover, *WMS Gaming* and *Harris* do not conflict with *Dossel*, which is not "on all fours" with this case, as Aristocrat asserts (Br. 48-49). The Court in *Dossel*, 115 F.3d at 947, emphasized that its ruling was based on "the specific facts" of that case, which involved a patent that contained a detailed description of the structure corresponding to the function. The specification referenced "known algorithms" that "can be used to solve standard equations which are known in the

art,” as well as disclosing that the device at issue “computes, from the received data, the current distribution by mathematical operations including a matrix inversion or pseudo inversion, and then outputs the result to a display.” *Id.* at 946-47. Thus it described the steps that constitute an algorithm — solving of equations, reception of data, computation thereon of the current distribution by specified mathematical operations (including a matrix or pseudo inversion), and output of the result to a display. That combination of algorithms, steps, and expressly described mathematical operations sufficiently disclosed the structure of the means to satisfy the definiteness requirements of § 112.

Thus, Aristocrat is wrong to say (Br. 48-49, 53) that in *Dossel* “no algorithm was disclosed in the written description” and that “a computer was the structure that performed the function.” The structure disclosed in *Dossel* was not a bare computer but rather a special purpose computer programmed to perform the referenced algorithms and mathematical operations. In short, *Dossel*, *WMS Gaming*, *Harris*, and the ruling below are entirely consistent: they all recognize that the description of a computer-based means-plus-function claim must disclose an algorithm or equivalent structure to avoid invalidity for indefiniteness.<sup>3</sup>

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<sup>3</sup> Aristocrat’s contention that *WMS Gaming* conflicts with *Dossel* not only is novel and baseless but difficult to reconcile with the fact that two members of the panel that decided *WMS Gaming* (Judges Rader and Schall) were also on the panel that decided *Dossel*. Moreover, the *WMS* panel did not even mention *Dossel*, much less depart from it.

b. Aristocrat cannot conjure up the required algorithm or equivalent structure.

Aristocrat contends that the '102 patent discloses structure beyond the “standard microprocessor base[d] gaming machine by means of appropriate programming” disclosed in the specification. Specifically, Aristocrat argues (Br. 31-35, 49-50) that the claim itself, as well as the figures and embodiments, disclose a specific algorithm.

As an initial matter, that contention is barred by waiver and estoppel. In the district court, as the district court noted, “Aristocrat acknowledge[d] that there is only one corresponding structure for all three aspects, namely the ‘standard microprocessor based gaming machine under program control, plus equivalents.’” JA0003. Indeed, Aristocrat represented that “there is simply no other structure disclosed in the patent specification that could perform this [game control] function.” JA0769. In addition, Aristocrat responded to Interrogatory No. 3(b), which asked it to “identify the structure identified in the specification of the '102 PATENT,” as follows:

This element is in a means-plus-function format. The game control means would correspond to the ‘standard microprocessor machine’ structure plus programming disclosed in the patent specification.

JA0193. Aristocrat may not seek to broaden the structure it identified below on appeal. See *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 715 (Fed. Cir.

1998) (a party to an appeal may not alter the claim construction it advocated in the district court).

In any event, Aristocrat's hunt for structure in the '102 patent is futile. Aristocrat first contends (Br. 31-32) that the claim itself discloses the required structure because it "implicitly discloses an algorithm for the microprocessor with appropriate programming." But if the claim itself disclosed the means, there would be no need to rely on § 112, ¶ 6 and the *quid pro quo* it embodies. See *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003) (claim that recites structure rebuts presumption that it is a means-plus-function claim). Yet, Aristocrat admits that ¶ 6 governs its claim. Moreover, Aristocrat waived its "claim implies an algorithm" argument by failing to raise it in the district court. See *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1426 (Fed. Cir. 1997) ("appellate courts do not consider a party's new theories, lodged first on appeal").

Even if not waived, what is the algorithm that claim 1 "implicitly" discloses? According to Aristocrat (Br. 31), it is that "the program should pay a prize when the winning combination of symbols is displayed." Or, as Aristocrat re-phrases it (*id.* at 32), "IF a winning combination of symbols is displayed, THEN pay a prize." But those are not algorithms that describe step-by-step how the machine performs the function. They simply restate one of the functions claimed in the '102 patent — pay a prize when a predetermined combination of symbols matches the symbol

positions selected by the player (See JA0308 (Col. 6, lns. 1-3)) — rather than disclose structure for carrying out that function. See *Medical Instrumentation*, 344 F.3d at 1211 (rejecting attempt to “claim in functional terms unbounded by any reference to structure in the specification”); accord *Biomedino*, 490 F.3d at 948.

Aristocrat’s reliance (Br. 32) on *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374 (Fed. Cir. 1999), is misplaced. There was no contention in *Atmel* that the claim itself disclosed the structure. Rather, the specification included an express reference to an article that described the structure of the corresponding function. The specification of the ’102 patent includes no such reference. See *Biomedino*, 490 F.3d at 952 (distinguishing *Atmel*).

Aristocrat further contends (Br. 32) that Claim 1 “sets forth the mathematical equation that describes the result of practicing the third function.”

Aristocrat identifies that equation as the following reference:

the number of said predetermined arrangements for any one game is a value which is the product  $k_1 \cdot \dots \cdot x \cdot \dots \cdot k_i \cdot \dots \cdot x \cdot \dots \cdot k_m$  where  $k_i$  is a number of symbol positions which have been selected by the player in an  $i^{\text{th}}$  column of the  $n$  rows by  $m$  columns of symbol positions on the display ( $0 < i \leq m$  and  $k_i \leq n$ ).

*Id.* (quoting JA0308 (Col. 6, lns. 13-17)). But merely providing an equation that produces a result does not disclose the structure required by § 112, ¶ 6. As Aristocrat admits (*id.*), the referenced equation merely “describes the total number of possible winning opportunities.” Moreover, Aristocrat previously refers (Br.

27) to that same “mathematical equation” reference as mere “functional language.” Again, Aristocrat cannot rely on such “functional language” as the structure of the means to the recited function. *Medical Instrumentation*, 344 F.3d at 1212.

Aristocrat also argues (Br. 33) that the specification of the '102 patent discloses the required structure “through the disclosed embodiments of the invention.” But those embodiments merely provide diagrams of a player’s hypothetical selections and tables that correspond to those selections. JA0307 (Col. 3, Ins. 54-56) (Figure 1) (Table 1). At bottom, they provide only different examples of how to play the game; in Aristocrat’s words (Br. 34), they “relate a hypothetical player’s selections to the resulting winning opportunities.” Stating that varying player selections varies winning opportunities does not describe how the gaming machine works, that is, the specific sequence of steps by which it performs the recited functions, or indicate what “appropriate programming” means. After all, what is at issue is an apparatus claim directed to a gaming machine, not a method of play. See JA0308 (Col. 5, ln. 63 – Col. 6, ln. 66). It has long been settled that “patentability of apparatus claims must depend upon structural limitations and not upon statements of function.” *In re Michlin*, 256 F.2d 317, 320 (C.C.P.A. 1958).

The '102 patent specification not only fails to identify an algorithm, it also fails to identify anything else that would transform a general purpose computer

into a special purpose one. It does not identify a particular software program, an “appropriate” software program category, a particular software program provider, a book or manual (or even an article as in *Atmel*) describing a software program, or a chart or diagram illustrating structure corresponding to the asserted means. It offers nothing but a “standard” computer and unspecified programming.

Finally, Aristocrat suggests (Br. 41) that the ’102 patent specification sufficiently discloses the required structure because methods for performing the recited functions are “well known.” But this Court recently rejected a similar contention in *Biomedino*. There, the claimed function was “automatically operating valves,” and the specification provided that the regeneration process may be “controlled automatically by *known* differential pressure, valving and control equipment.” 490 F.3d at 950 (emphasis added). The Court rejected the notion that it was sufficient for the specification to recite “that a claimed function can be performed by known methods or using known equipment,” notwithstanding prior art of record and expert testimony that such known methods and equipment exist. *Id.* at 951.

In any event, the ’102 patent does not speak of “known” programming but only of “appropriate” programming. JA0307 (Col. 3, lns. 3-4). “Appropriate” is even more vague and subjective than “known”; in fact, an “appropriate” program may not be “known” at all. The word “appropriate” cannot compensate for the

lack of an algorithm or other description of corresponding structure. In *Datamize*, 417 F.3d at 1352-53, this Court held that a description of supposed structure was too indefinite because it depended on an “undefined” or “purely subjective” standard. Here, too, the specification offers no definition nor even a clue as to the meaning of “appropriate.” What is appropriate to one skilled in the art may not be appropriate at all to another skilled in the art, and in any event “appropriate” is far too vague a term to satisfy the definiteness requirement. See *id.* at 1350. If “known” cannot cure indefiniteness, as the Court held in *Biomedino*, then *a fortiori* the even more vague and subjective “appropriate” cannot do so.

In sum, Aristocrat’s attempt to conjure up an algorithm or equivalent structure comes up empty. As the district court determined, Aristocrat can point to nothing in the ’102 patent that discloses the steps by which a computer is to perform the claimed functions. It does not provide any instructions or guidance as to how a gaming machine can be improved to control images on its display means, pay a prize, or define pay lines in accordance with the claimed novelty of the invention. The purported algorithms simply restate the recited functions. Such a summary of the desired result does not answer the *structural* question of what makes it happen. Under Aristocrat’s view, *any* slot machine performing the recited functions with a computer & software — no matter how differently it performs

those functions — would infringe the '102 patent. That is not and should not be the law.

Innovation is fostered by allowing inventors to design a new structure that improves on established means of achieving a function. A patentee would reap a windfall if it could expand the scope of the patent beyond structures and their equivalents specifically disclosed in the specification. That is why this Court has made clear that the specification of a computer-based means-plus-function claim must disclose a “special purpose” computer to perform the recited functions.

**B. Aristocrat’s Expert Cannot Overcome The Specification’s Failure To Disclose Corresponding Structure.**

Aristocrat attempts to compensate for the failure of the specification to disclose corresponding structure by offering a declaration from Dwight Crevelt, an engineering consultant. Crevelt opined that “a person of ordinary skill in the art would understand that the ‘game control means’ is a microprocessor under program control” (JA0518, ¶ 8); “a person of skill in the art would link the claimed functions of the ‘game control means’ to the disclosed microprocessor and programming identified in the patent specification” (*id.*); and that “implementation of these functions on a microprocessor based gaming device [would] be a simple and straightforward programming task that would be well within the capabilities of a person of ordinary skill” (*id.*, ¶ 9). Significantly, Crevelt did not identify any

structure in the '102 patent other than an unspecified microprocessor under unspecified program control.

Aristocrat relies (Br. 35-36) on the truism that the sufficiency of the disclosure of structure is evaluated from the perspective of a person of ordinary skill in the art. But as this Court recently reaffirmed, the testimony of one skilled in the art “cannot supplant the total absence of structure from the specification.” *Biomedino*, 490 F.3d at 950. Thus, Aristocrat “cannot use the declaration of its expert to rewrite the patent’s specification” or use “conclusory testimony” to supply structure that is not disclosed in the patent itself. *Default Proof*, 412 F.3d at 1302.

In fact, Crevelt acknowledged that necessary hardware and algorithms “are not mentioned in the patent claims” but suggested that they may have been “already incorporated into existing microprocessor based gaming devices.” JA0519 ¶ 11. Similarly, he recognized that the specification does not specify “the programming for the microprocessor” but opined that “a person of skill in the art during the relevant time period would use their existing game platform [and] reprogram it to implement any new games.” JA0728-0729 ¶ 15. This testimony simply confirms that the '102 patent discloses insufficient structure.

An expert’s opinion that a person of skill in the art would be *capable* of implementing a structure does not satisfy the statutory requirements. *Biomedino*,

490 F.3d at 953. As the Court explained when finding a means-plus-function claim invalid for indefiniteness in *Medical Instrumentation*, “[e]ven if one skilled in the art would know that software is capable of performing the function of converting images into a selected format, there is nothing in the patents to suggest that it must be the structure that would perform the function in this invention.” 344 F.3d at 1217-18; accord *Default Proof*, 412 F.3d at 1302; *Cardiac Pacemakers*, 296 F.3d at 1118-19. Aristocrat’s reliance on *Atmel* is unavailing because the Court in that case agreed that “consideration of the understanding of one skilled in the art in no way relieves the patentee of adequately disclosing sufficient structure in the specification.” 198 F.3d at 1380.

Disagreeing with these precedents, Aristocrat (Br. 39-40) rejects the principle that an expert may not supply the required structure where the patent itself fails to disclose it, calling this a “false dichotomy.” According to Aristocrat (*id.* at 40), there is “no logical distinction” between an expert’s supplying structure and a specification’s disclosing structure because one is “subsumed” in the other. But the Court’s cases embody that dichotomy and distinction, and with good reason. The *quid pro quo* for the generic claiming ability offered by § 112, ¶ 6 would be negated if a patentee could dispense with the required disclosure of structure and instead rely on an expert’s declaration in the event of litigation. On that basis, the Court in *Biomedino*, 490 F.3d at 953, rejected an argument much

like Aristocrat's, holding that an expert's "bare statement that known techniques or methods can be used does not disclose structure" and explaining that to hold otherwise "would vitiate the language of the statute requiring corresponding structure, material, or acts described in the specification."

Based on these well settled principles, the district court properly refused to allow Aristocrat's expert to supply structure not found in the '102 patent.

**III. ALTERNATIVELY, THE '102 PATENT IS FATALLY INDEFINITE BECAUSE ITS SPECIFICATION FAILS TO LINK ANY STRUCTURE TO THE RECITED FUNCTIONS.**

The district court properly found that the '102 patent fails to link any structure to the claimed functions.<sup>4</sup> Even if the specification of the '102 patent sufficiently disclosed the necessary structure (it does not, as demonstrated above), it would fail to satisfy the requirements of § 112. "It is not enough simply to list a certain structure in the specification; that structure must also be clearly *linked* to a claimed function in order to be a corresponding structure for that function." *Medical Instrumentation*, 344 F.3d at 1218 (emphasis added); accord *Default Proof*, 412 F.3d at 1299 (means-plus-function limitation requires that structure be

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<sup>4</sup> Aristocrat (Br. 2) contends that the district court ruled "inconsistently" by determining first that the specification disclosed no structure and second that there was an insufficient link between any structure and the claimed function. These were alternative — not inconsistent — rulings (see JA0010-0011), and we offer the "insufficient link" argument in the alternative here as well.

“clearly linked”); *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed. Cir. 1997).

In *Medical Instrumentation*, 344 F.3d at 1217, for example, although the specification mentioned “software programs that ‘are either commercially available or within the skill of practitioners in the programming arts,’” the Court found that this reference “in no way links software to the function of converting images into a selected format.” Similarly, in *Medtronic, Inc. v. Advanced Cardiovascular Sys., Inc.*, 248 F.3d 1303, 1311 (Fed. Cir. 2001), the Court found that the patent specification did disclose structure that was capable of performing the recited function, namely straight wire, hooks, and sutures. But the Court proceeded to find that this structure was not “clearly linked or associated with the function of connecting adjacent elements together,” rendering the means-plus-function claim indefinite. See also *Default Proof*, 412 F.3d at 1299 (“the specification fails to clearly link the POS terminal, or any part thereof, to the distributing function”); *JVW Enters., Inc. v. Interact Accessories, Inc.*, 424 F.3d 1324, 1330 n.1 (Fed. Cir. 2005); *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1332 (Fed. Cir. 2003).

The ’102 patent specification does not disclose any such link. Indeed, not a single reference to the claim term “game control means,” “game control,” or

“control” appears anywhere in the detailed description of the invention or in any of the figures. JA0306 (Col. 2, ln. 65) – JA0308 (Col. 5, ln. 61).

Aristocrat (Br. 42) insists that the specification of the ’102 patent “provides the required link.” In particular, Aristocrat contends (*id.* at 43) that the embodiments “illustrate the methodology of converting a player’s symbol position selections into winning opportunities.” But a “methodology” of converting a player’s symbol position selections into winning opportunities does not provide a link between the alleged structure and the machine’s game control functions. A method of play is neither a gaming machine function nor corresponding structure with respect to the apparatus claim at issue. See *Mars Inc. v. Kabushiki-Kaisha Nippon Conlux*, 24 F.3d 1368, 1375 (Fed. Cir. 1994) (distinguishing “method claims” from “apparatus claim”); *Adrain v. Superchips, Inc.*, 218 F. App’x 982, 983 n.1 (Fed. Cir. 2007) (same). As the district court put it, “the only link argued by Aristocrat to the alleged structure is the methodology, not the functions performed by the game control means.” JA0011.

Aristocrat (Br. 44) again relies on a declaration from its expert to contend that one skilled in the art would “readily understand that the claimed functionality of ‘game control means’ is being performed by a microprocessor programmed to interpret the player’s selections exemplified in Figure 1 as a selection of the winning opportunities identified in Table 1.” But it is impermissible to rely on

expert declarations to supply a link between structure and function not disclosed in the patent specification. See *Omega Eng'g*, 334 F.3d at 1332 (patentee “impermissibly relies on expert declarations to clearly link” the claimed function and structure).

Moreover, Aristocrat’s expert fails to identify the missing link. Crevelt simply describes the method of play (the player makes selections that define winning opportunities) without showing how the specification links the purported structure (programmed microprocessor) to the claimed functions. Nor can Aristocrat overcome the lack of any such link in the specification by pointing (Aristocrat Br. 44) to Crevelt’s opinion that “it was a common practice in 1994 to use microprocessors to display symbols, determine winners, and make payouts.” True or not, that bit of history does not supply the link between the purported structure and the claimed functions. “There must be something *in the disclosure* to indicate to the public that the patentee intends for a particular structure to correspond to a claimed function.” *Medical Instrumentation*, 344 F.3d at 1217-18 (emphasis added).

Aristocrat (Br. 45-46) criticizes the district court for relying on *Braun* and *Medical Instrumentation* to require disclosure of a link between structure and function. According to Aristocrat (*id.* at 46), those cases involved “multiple” structures whereas in this case “no structure other than the recited microprocessor

with appropriate programming could perform the recited ‘game control means’ functions.” That is a distinction without a difference. Whatever the structure, and whether it is singular or multiple, this Court’s precedents require that it be linked to the claimed functions. That requirement is the *quid pro quo* for the convenience of employing § 112, ¶ 6. *Braun*, 124 F.3d at 1425; *Medical Instrumentation*, 344 F.3d at 1219.

#### **IV. ARISTOCRAT’S ADDITIONAL ARGUMENTS ARE BASELESS.**

Aristocrat raises two additional arguments to support its demand that the district court judgment be reversed. Neither has any merit.

First, Aristocrat argues (Br. 22-23) that the district court erred by failing to construe the term “game control means” before determining whether the patent disclosed sufficient structure and therefore jumped the gun by awarding summary judgment. But the district court, after reprising the parties’ views of the claimed functions, reasonably concluded that it had no need to choose between them given the failure of the specification to disclose any structure. JA0007. As the court explained (*id.*), construction of the functions was “not pertinent to the summary judgment motion.” Aristocrat (Br. 23) calls that conclusion “plainly an error” but does not suggest how a construction of the functions would have made *any* material difference to the primary issue before the court — whether the specification discloses the required structure. Moreover, when no structure is

disclosed for a means-plus-function term, the claim is indefinite and cannot be construed. See *Honeywell*, 341 F.3d at 1338 (an indefinite claim “is not ‘amenable to construction’”); *Default Proof Credit Card Sys., Inc. v. Home Depot U.S.A., Inc.*, 389 F. Supp. 2d 1325, 1342 (S.D. Fla. 2004), aff’d, 412 F.3d 1291 (2005).

Other courts, too, have held a means-plus-function claim invalid for indefiniteness prior to entering a *Markman* order. See, e.g., *Datamize, LLC v. Plumtree Software, Inc.*, 2004 U.S. Dist. LEXIS 28382, at \*7 (N.D. Cal. July 9, 2004) (granting summary judgment of invalidity due to indefiniteness prior to scheduled claim construction hearing), aff’d, 417 F.3d 1342 (Fed. Cir. 2005); *DE Tech.*, 428 F. Supp. 2d at 514-15 (same). Aristocrat’s reliance on *Oakley, Inc. v. Sunglass Hut Int’l*, 316 F.3d 1331 (Fed. Cir. 2003), is misplaced. *Oakley* did not involve a means-plus-function claim and merely stands for the general truism that an infringement analysis requires “construction of the claims.” *Id.* at 1340.

It follows, then, that granting Aristocrat’s request (*id.*) that this Court construe the term “game control means” would serve no purpose. The issues before the Court are whether the specification discloses the required structure and, if so, whether it links that structure to the claimed functions. If the Court agrees with the indefiniteness ruling of the district court, there will be no need to construe other patent terms (even if it were possible). If the Court reverses, the district court will have full opportunity to construe the claims in full.

Second, Aristocrat argues (Br. 55) that the prosecution history makes the presumption of validity “particularly strong” in this case because the PTO examiner allowed the ’102 patent to issue after this Court’s decisions in *Dossel* and *WMS Gaming*. Aristocrat cites no case supporting that remarkable proposition. To be sure, 35 U.S.C. § 282 provides a presumption of validity for issued patents. But that presumption is overcome by clear and convincing evidence of indefiniteness. *Medical Instrumentation*, 344 F.3d at 1220. As the district court properly ruled, the failure of the ’102 patent specification to disclose any structure was clear and convincing evidence of indefiniteness sufficient to overcome any presumption of invalidity.

### CONCLUSION

For the foregoing reasons, the district court’s judgment that the ’102 Patent is invalid as indefinite should be affirmed.

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Respectfully submitted,

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**CERTIFICATE OF SERVICE**

The undersigned, an attorney, hereby certifies that on October 11, 2007 she caused two copies of the Corrected Brief of Defendants-Appellees International Game Technology and IGT to be served upon the following by United Postal Service overnight express:

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**CERTIFICATE OF COMPLIANCE WITH  
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1. This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 32(a)(7)(B).

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